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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,065	02/13/2004	Eric Metrot	P24947	4111
7055	7590	05/19/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			BASINGER, SHERMAN D	
			ART UNIT	PAPER NUMBER
			3617	
DATE MAILED: 05/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/777,065

Applicant(s)

METROT, ERIC

Examiner

Sherman D. Basinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/321,392.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 6,692,321.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 24 of the patent includes all of the limitations of claim 1 of the instant application.

Claim 24 of the patent depends from claims 21 and 1 of the patent. Underlined is the subject matter of claims 1, 21 and 24 of the patent which is set for in claim 1 of the instant application.

A hollow surfboard comprising an outer shell having at least one inner cavity, a support zone for a front foot of a surfer and a support zone for a rear foot of a surfer, both of said support zones comprising upwardly facing surfaces of the surfboard adapted to be directly beneath the front foot and the rear foot of the surfer; at least one inertial mass,

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wherein said at least one inertial mass comprises means for modifying dynamic behavior of the surfboard during surfing by the surfer, wherein said inner cavity has a height and wherein said inertial mass extends vertically over said height of said inner cavity of the surfboard.

Except for minor changes in verbiage such as "said" and "the", "has" and "having" and "extends" and "extending", claim 24 of the patent includes all of the limitations of claim 1 of the instant application. Therefore, one making the surfboard of claim 24 of the patent would also make the surfboard of claim 1 of the patent. Thus, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the surfboard of claim 1 of the instant application by making the surfboard of claim 24 of the patent. Motivation to do so is to make a surfboard which uses inertial mass to modify its behavior.

3. Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,692,321. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of the patent includes all of the limitations of claim 2 of the instant application.

Claim 9 of the patent depends from claim 6 of the patent. Underlined is the subject matter of claims 6 and 9 of the patent which is found in claim 2 of the instant application.

A hollow surfboard comprising an outer shell having at least one inner cavity, a support zone for a front foot of a surfer and a support zone for a rear foot of a surfer, at least

one inertial mass, said at least one mass comprising two masses symmetrically arranged on each side of a longitudinal median plane of the surfboard, wherein said inner cavity has a height and wherein said mass extends vertically over said height of the inner cavity of the surfboard.

The differences in the limitations found in claims 6 and 9 of the patent and claim 2 of the instant applicant are minor and include "said" instead of "the", "each side" instead of "on opposite sides" and "extending" instead of "extends". As such, in making the surfboard of claim 9 of the patent, one would end up making the surfboard of claim 2 of the instant application. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the surfboard of claim 2 of the instant application by making the surfboard of claim 9 of the patent. Motivation to do so is to make a surfboard which uses inertial mass to modify its behavior.


### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sherman D. Basinger  
Primary Examiner  
Art Unit 3617  
5/14/04

sdb  
5/14/04